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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,698	11/29/2001	Andrew C. Gilbert		2615

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MARY ANN GILBERT  
5 SCARLET OAK ROAD  
CALIFON, NJ 07830

EXAMINER
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KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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04/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/995,698	<b>Applicant(s)</b> GILBERT ET AL.	
	<b>Examiner</b> Hani Kazimi	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 11 and 17-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 11 and 17-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                            | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed on March 25, 2009. Claims 1-7, 10, 11 and 17-57 are pending in the application. The objections and rejections are as stated below:

### ***Claim Objections***

2. Claims 4 and 11 are objected to because of the following informalities:  
  
In particular, claims 4 and 11 are duplicates, either claim 4 or 11 has to be amended or canceled. Appropriate correction is required.

### ***Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. *Vas-Cat, Inc. v.*

Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 17-33 and 45-55 include the limitation of "...receiving a parameter from a user designating a relationship specifying the timing at when the bid and offer are to be brought to market relative to each other, the timing relationship being enforced by the trading system..." However, the specification does not provide an enabling disclosure to support the claimed step of "...receiving a parameter from a user designating a relationship specifying the timing at when the bid and offer are to be brought to market relative to each other, the timing relationship being enforced by the trading system..."

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**4.** Claims 17-33 and 45-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 17-33 and 45-55 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 10, 11 and 17-57 are rejected under 35 U.S.C. 102 (e) as being anticipated by Woodmansey et al. US Pat. No. 7,155,410 B1, (hereinafter “Woodmansey”).

Claims 1-3, 10, 31-33, 42, 43, 54, 55, Woodmansey discloses a method for use in an electronic trading system, the method comprising the acts of:

receiving a bid at the electronic trading system (abstract, column 3, lines 56-67);

receiving at the electronic trading system a designation of a linking parameter linking the bid to an offer based on historical market data (column 8, lines 41-47), and generating an offer based at least in part on the received bid and the received designated linking parameter (abstract, column 2, lines 40-50, column 5, lines 37-48);

receiving a parameter from a user designating a relationship specifying the timing at when the bid and offer are to be brought to market relative to each other, the timing relationship between the bid and offer being enforced by the trading system (column 5, lines 37-48, fig. 5, element 512, column 6, lines 26-41, and column 11, lines 5-8).

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Claims 4-7, 11 and 49, Woodmansey discloses the steps of prompting a user to input the linking parameter (fig. 2A, element 204, and column 5, lines 37-48), generating a price spread between the bid and the offer, generating a size of the offer based on a size of volume spread between the bid and the offer, and generating a price spread and a size of the offer based on a size of volume spread between the bid and the offer (column 2, lines 58-65, column 4, line 46 thru column 5, line 20).

Claims 17, 34, 35, 44, 45, 56 and 57, Woodmansey discloses a method and computer readable medium programmed to cause an electronic trading system to:

generating an electronic record of an order to trade on behalf of a trader on a market implemented in an electronic trading system, and holding the order record in abeyance from the market (abstract, column 3, lines 56-67);

generating an electronic record of a counter-order to trade on behalf of the same trader, the counter-order having a parameter linked to a parameter of the order such that the linked parameter of the counter-order will fluctuate over time with market conditions (abstract, column 2, lines 40-50, column 5, lines 37-48); and

under control of the electronic trading system, substantially simultaneously bringing to market the order and the counter-order (fig. 5, element 512, column 6, lines 26-41, and column 11, lines 5-8).

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Claims 18 and 19, Woodmansey discloses that the order is a bid to buy, and the counter-order is an offer to sell and the order is an offer to sell, and the counter-order is a bid to buy (column 1, line 60 thru column 2, line 57).

Claims 20-22, 36, 37, 46-48, Woodmansey discloses that the linking of the parameters is performed at the explicit request of the trader as the counter-order is entered (abstract), the electronic trading system provides to the trader a screen display interface for entering the order and counter-order, and the screen display interface has the capability of prompting the trader to enter the order and counter-order as linked bid and offer (fig. 3).

Claims 23-25, 38 and 50, Woodmansey discloses that the parameters of the order and counter-order to be linked are detected at least in part automatically by the electronic trading system; the electronic trading system issues a prompt to the trader to link the order and counter-order, wherein the counter-order is generated at least in part automatically by the electronic trading system in response to the generating of the order (abstract, column 2, lines 40-50, column 5, lines 37-48).

Claims 26 and 27, Woodmansey discloses that the order and counter-order are for items that are the same as each other, in the sense of being fungible instances of the item (column 5, lines 21-57).

Claims 28-30, 39-41 and 51-53, Woodmansey discloses that the size of the counter-order is linked as a function of the size of the order, the price of the counter-order is linked as a function of the price of the order, and the size of the counter-order is linked as a function of the price of the order (column 2, lines 3-15, column 6, line 59 thru column 7, line 29 and column 8, line 65 thru column 9, line 58).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-7, 10, 11 and 17-57 have been considered but are not persuasive.

Woodmansey explicitly teaches that a user can designate the sequence of the placement of orders (col. 5, lines 37-48).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691